

REMARKS

The application has been amended to place the application in condition for allowance at the time of the next Official Action.

A replacement drawing figure is submitted for Figure 8 correcting the spelling of "PRIOR".

The title of the invention has been changed to address the specification objection noted in the Official Action.

Claims 1-26 are pending in the application. Claims 4, 8, 13, 18, and 22 are withdrawn from consideration as being directed to a non-elected species. Applicant would like to thank the Examiner for indicating allowable subject matter in claims 3, 7, 12, 17, 21, and 23.

Claims 2-9, 11-14, and 16-26 are rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. The Official Action indicates that the claim language "non-deformable member" and "a rigid member" constitute new matter not supported by the original disclosure.

Reconsideration and withdrawal of the rejection are respectfully requested because applicant believes that the specification as filed reasonably conveys to one of ordinary skill in the art that the scratch prevention members 10 or 15 are non-deformable and/or rigid.

Figure 4 of the present application shows an example of a rigid or non-deformable scratch preventing patch 10. As seen

from Figure 4, felt member 4 is deformed. However, the scratch preventing member 10 does not deform. It is important that member 10 does not deform so that the disk 1 does not contact edge portion 3a when the disk is being removed from or inserted into discharge slot 3.

In contrasting Figure 4 with prior art Figure 5, page 15, lines 1-10 of the present application disclose that because of the lack of patch 10 for scratch prevention, when the disk 1 deviates from the normal position at the insertion or discharge of the disk, the disk comes into contact with the edge portion 3a of the insertion and discharge slot 3 which causes scratches on the surface of the disk 1. Accordingly, in order to prevent contact with the edge portion 3a, one of ordinary skill in the art would understand that scratch prevention member 10 is rigid or non-deformable.

MPEP §2163 II.3 provides that a determination of whether there is sufficient written description to inform the skilled artisan that the applicant was in possession of the claimed invention is based on the invention as a whole. §2163 II.3(b) provides that the Examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims.

To comply with the written description requirement of 35 USC §112, first paragraph, each claim limitation must be

expressly, implicitly, or inherently supported in the originally filed disclosure.

In order to prevent contact of the surface of the disk with the edge portion of the discharge slot 3, one of ordinary skill in the art would understand that the scratch preventing member 10 would have to be rigid or non-deformable. If such member 10 was not rigid or non-deformable, pressure exerted on the disk causing the member to deform would cause the disk to contact edge portion 3a, which applicant is trying to prevent. Accordingly, applicant asserts that claims 2-9, 11-14, and 16-26 are supported by the specification as filed so as to reasonably convey to one of ordinary skill in the art that the inventors had possession of the claimed invention at the time the application was filed, and thus the rejection should be withdrawn.

Claims 6, 9, and 20 are rejected as anticipated by ISOMURA JP 63-187492. This rejection is respectfully traversed.

The Official Action has indicated that members 21b and 22b of ISOMURA are members for preventing scratching of the disk medium. However, claim 6 provides that the member for preventing scratches of the disk medium is a non-deformable member. ISOMURA discloses members 21b and 22b as dust-proof members made of a material such as felt-made pad. Felt-made pad is deformable.

MPEP §2163(06)I provides that: "The Examiner should still consider the subject matter added to the claim in making

rejections based on prior art since the new matter rejection may be overcome by applicant.

It appears that the Examiner did not consider the non-deformable aspect of claims 6 and the substantially rigid aspect of claim 20. Since the above-noted limitations are not believed new matter and since ISOMURA does not disclose or suggest these features, claims 6, 9, and 20 are believed patentable over ISOMURA.

Claims 1, 10, and 15 are rejected as unpatentable over KATO JP 2000-298906 in view of applicant's disclosed prior art Figure 5. This rejection is respectfully traversed.

Applicant submits herewith a verified English translation of Japanese priority document 2000-314199 to perfect the claim to priority and remove KATO as a prior art reference.

Claims 2, 5, 11, 14, 16, 19 and 24-26 are rejected as unpatentable over KATO in view of applicant's disclosed prior art and further in view of ISOMURA. This rejection is respectfully traversed.

Claims 2, 5, 11, 14, 16, 19, and 24-26 depend from one of claims 1, 10, and 15, respectively. As set forth above regarding these claims, perfecting the claim to priority removes KATO as a prior art reference. Accordingly, claims 2, 5, 11, 14, 16, 19, and 24-26 are believed patentable over the cited prior art.

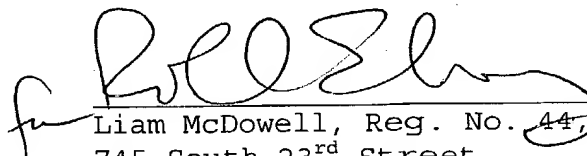
Since claims 1, 2, 6, 10, 11, 15, 16, 20, and 21 are indicated as generic in the Official Action of October 8, 2003 and since these claims are believed allowable, withdrawal of the election of species requirement and allowance of all the claims are respectfully requested.

In view of the present amendment and the foregoing remarks, it is believed that the present application has been placed in condition for allowance. Reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON

 41949
Liam McDowell, Reg. No. 44,231
745 South 23rd Street
Arlington, VA 22202
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

LM/mjr